

REMARKS

Claims 1-8 have been examined, and claims 9-14 have been withdrawn from consideration for being directed to a non-elected invention. Accordingly, Applicants have canceled claims 9-14 without prejudice or disclaimer and reserve the right to file a divisional application to continue prosecuting these claims.

Of the examined claims, claims 6 and 7 have been rejected under 35 U.S.C. § 112, second paragraph, claim 6 has been rejected under 35 U.S.C. § 112, first paragraph, and claims 1, 2, and 4-8 have been rejected under 35 U.S.C. § 103(a). Also, the Examiner acknowledges that claim 3 contains allowable subject matter.

I. Rejection under 35 U.S.C. § 112, second paragraph

Claims 6 and 7 have been rejected under 35 U.S.C. § 112, second paragraph. Applicants submit that the amendments to these claims overcome the rejection.

II. Rejection under 35 U.S.C. § 112, first paragraph

Claim 6 has been rejected under 35 U.S.C. § 112, second paragraph. Applicants submit that the amendments to the claim overcome the rejection.

III. Rejection under 35 U.S.C. § 103(a) over U.S. Patent No. 4,755,752 to Fitzpatrick, PCT Publication No. WO 98/275,570 (“WO ‘570”), and/or U.S. Patent Publication No. 2002/0009536 to Iguchi et al. (“Iguchi”)¹

Claims 1, 7, and 8 have been rejected under 35 U.S.C. § 103(a) over Fitzpatrick, WO ‘570, and Iguchi. Applicants submit that the claims are patentable over the references.

¹ Since Iguchi is the English equivalent to WO ‘570, Applicants will collectively refer to both references as Iguchi in this Amendment.

A. Claim 1

For example, claim 1 relates to a method of manufacturing a plasma display panel in which a phosphor material is applied to a plurality of cells. Then, the method inspects whether or not the phosphor material is properly applied to the cells prior to drying the phosphor material.

On page 4 of the Office Action, the Examiner acknowledges that Fitzpatrick and Iguchi do not suggest inspecting a phosphor material prior to drying the phosphor material. Nonetheless, the Examiner maintains that “the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results,” and he relies on the case *In re Burhans*, which was decided 60 years ago to support his position. Applicants respectfully disagree with the Examiner’s analysis and submit that the claimed features above would not have been obvious.

For example, the Federal Circuit has expressly held that the Examiner’s reliance on case law to support propositions, such as the reordering of process steps is *prima facie* obvious, is improper. Specifically, the Court held that “[t]his method of analysis is founded on legal error because it substitutes supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *In re Ochiai*, 71 F.3d 1565, 1570, 37 U.S.P.Q.2D (BNA) 1127, 1132 (Fed. Cir. 1995). In fact, in *In re Ochiai*, the Court provided a detailed clarification of what it perceived to be a frequent misunderstanding among Examiners.

The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention -- including all its limitations -- with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease. Any such

administrative convenience is simply inconsistent with section 103, which, according to Graham and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any *per se* rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract *per se* rules from decisions that disavow precisely such extraction. (Emphasis added)

In re Ochiai, 71 F.3d 1565, 1572, 37 U.S.P.Q.2D (BNA) 1127, 1134 (Fed. Cir. 1995).

The Examiner clearly acknowledges that none of the references suggests inspecting a phosphor material prior to drying the phosphor material and relies on overruled case law to support his conclusion that reordering of process steps would have been obvious. Under *In re Ochiai*, this conclusion is improper and does not render the claimed features obvious. As such, Applicants submit that claim 1 is patentable.

Also, even assuming *arguendo* that the Examiner's interpretation of *In re Burhans* is still good law, Applicants submit that claim 1 is still patentable. Specifically, under the Examiner's interpretation of the case law, the reordering of process steps would have been obvious in the absence of new or unexpected results. However, in researching aspects of a non-limiting embodiment of the claimed invention, Applicants discovered that a condition of the phosphor material before the drying process is closely related to the quality of the phosphor material after the drying process. (See, e.g., page 10, line 12, to page 11, line 7, of the present application). As a result of this fact, an illustrative embodiment of the claimed method can determine whether or not phosphor material is acceptable or not in an earlier stage of the manufacturing process than the conventional method. Thus, the embodiment is able to increase the product yield of the plasma display panels.

Since the reordering of the process steps in the non-limiting embodiment can produce a new result, Applicants submit that claim 1 is patentable over the references, even under the Examiner's interpretation of the case law.

B. Claims 7 and 8

Since claims 7 and 8 depend upon claim 1, Applicants submit that they are patentable at least by virtue of their dependency.

IV. Rejection under 35 U.S.C. § 103(a) over Iguchi, Korean Application 1999-85889 ("KR '889"), and Fitzpatrick

Claims 1 and 5-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Iguchi, KR '889, and Fitzpatrick. Applicants submit that the claims are patentable over the reference.

A. Claim 1

For example, claim 1 relates to a method that inspects whether or not the phosphor material is properly applied to the cells prior to drying the phosphor material. On page 5 of the Office Action, the Examiner acknowledges that Iguchi, KR '889, and Fitzpatrick do not suggest inspecting phosphor material prior to drying. Thus, Applicants submits that claim 1 is patentable for at least the reasons presented above.

B. Claims 5-8

Since claims 5-8 depend upon claim 1, Applicants submit that they are patentable at least by virtue of their dependency.

V. Rejection under 35 U.S.C. § 103(a) over Iguchi, KR ‘889, and U.S. Patent No. 6,797,975 to Nishiyama et al. (“Nishiyama”)

Claims 1, 2 and 4-8² have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Iguchi, KR ‘889, and Nishiyama. Applicants submit that the claims are patentable over the reference.

A. Claim 1

As noted above, claim 1 relates to a method that inspects whether or not the phosphor material is properly applied to the cells prior to drying the phosphor material. On page 6 of the Office Action, the Examiner acknowledges that Iguchi, KR ‘889, and Nishiyama do not suggest inspecting phosphor material prior to drying. Thus, Applicants submits that claim 1 is patentable for at least the reasons presented above.

B. Claims 2 and 4-8

Since claims 2 and 4-8 depend upon claim 1, Applicants submit that they are patentable at least by virtue of their dependency.

VI. Allowable subject matter

The Examiner has objected to claim 3 for being dependent upon rejected base claim 1, but indicates that it contains allowable subject matter. Since the rejection of claim 1 is overcome, the objection to claim 3 is likewise overcome.

² Please note that the statement of the rejection states that only claims 1 and 5-8 are rejected over the references. However, since the body of the rejection analyzes claims 1, 2, and 4-8, Applicants assume that the Examiner intended to reject these claims over the references.

VII. Newly added claims

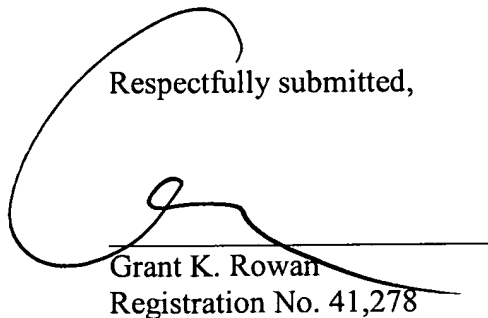
Applicants have added new claims 15 and 16. Since claim 15 contains features that are similar to the features discussed above in conjunction with claim 1, Applicants submit that it is patentable for at least similar reasons. Also, since claim 16 contains the allowable subject matter of claim 3, Applicants submits that it is patentable for at least similar reasons.

VIII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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